

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Jerding, Dean F., et al.

Serial No.: 09/590,434

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Confirmation No.: 1996

Group Art Unit: 2623

Examiner: Beliveau, Scott E.

Docket No.: A-6594 (191910-1480)

For: Bandwidth Allocation and Pricing System for Download Media Content

APPEAL BRIEF UNDER 37 C.F.R. §41.37

Mail Stop Appeal Brief – Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is an appeal under 37 C.F.R § 41.37, pursuant to the Notice of Appeal filed September 11, 2006, filed in response to the panel decision mailed September 26, 2006, affirming the Advisory Action mailed July 26, 2006 and the Final Office Action mailed May 11, 2006, rejecting claims 134 – 138 in the present application.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 20-0778.

I. REAL PARTY IN INTEREST

The real party in interest of the instant application is Scientific-Atlanta, Inc., having its principal place of business at 5030 Sugarloaf Parkway, Lawrenceville, GA 30044. Scientific-Atlanta, Inc., the assignee of record, is wholly owned by Cisco Systems, Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. STATUS OF THE CLAIMS

The Office Action rejects all pending claims 134 – 138. No claims are allowed. Applicant appeals the final rejection of claims 134 – 138

IV. STATUS OF AMENDMENTS

No amendments have been made or requested since the mailing of the FINAL Office Action and all amendments submitted prior to the FINAL action have been entered. The claims in the attached Claims Appendix (see below) reflect the present state of Applicant's claims.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter, described in the following, appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure. Additionally, reference to the embodiment of claim

134 is representative of one, among other, embodiments disclosed in the present application.

Embodiments according to independent claim 134 describe a television set-top terminal ("STT") 16 (page 6, line 1 and FIG. 3) coupled to a server via a bi-directional communication network. The STT 16 in claim 134 includes a memory 41 (page 6, second paragraph and FIG. 3) having at least one program code stored. The STT 16 in claim 134 also includes a processor 35 (page 6, third paragraph and FIG. 3) that is programmed to enable the STT to perform a plurality of operations. These operations included receiving, via a tuner 37 in the STT, media guide data corresponding to a media guide for on-demand rentable video presentations. The operations also include providing a media guide presentation to a user via a television signal, the media guide presentation comprising at least a portion (page 2, line 16). The operations also include, responsive to presentation of specific rent flags received from the server, enable a plurality of user-selectable rental options specific to each one of the plurality of on-demand rentable video presentations in the media guide presentation (page 21, line 1). The operations also include configuring a first rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation without presentation of promotional advertising that is otherwise shown during the presentation of the user-selectable on-demand rentable video presentation (page 21, line 28).

The operations also include a second rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation of the user-selected on-demand rentable video presentation (page 21, line 28). The operations also include receiving a first user input corresponding to a selection of one of the plurality of on-demand rentable video presentations in the media guide presentation (page 6, line

16). The operations also include providing the first rental option and the second rental option to the user responsive to the first user input (page 21, line 28). The operations also include receiving a second user input responsive to providing the first rental option and the second rental option (page 6, line 16). The operations also include providing the one of the plurality of rentable video presentations to the user without presentation of promotional advertising during the presentation and without preceding movie trailers responsive to the second user input corresponding to the selection of the first rental option and the second rental option (page 21, line 28).

The operations also include suspending the provision of the rentable video presentation and providing the user with suspension promotional advertising responsive to third user input, wherein the suspension promotional advertising provided during suspension of the presentation is configured by the server and is independent of the presentation and independent of the first rental option and the second rental option (page 29, line 7 and page 29, Line 30).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Independent claim 134 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Number 6,628,302 (“*White*”) in view of U.S. Patent Number 5,838,314 (“*Neel*”) in view of the *Bee article*, and in further view of U.S. Patent No. 5,914,746 (“*Matthews, IIF*”). Dependent claim 135 stands rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent Number 6,628,302 (“*White*”) in view of U.S. Patent Number 5,838,314 (“*Neel*”) in view of the *Bee article*, and in further view of U.S. Patent No. 5,914,746 (“*Matthews, IIF*”).

Dependent claims 136 – 138 stand rejected under 35 U.S.C. 103(a) as being allegedly

unpatentable over U.S. Patent Number 6,628,302 (“*White*”) in view of U.S. Patent Number 5,838,314 (“*Neel*”) in view of the *Bee article*, in view of U.S. Patent No. 5,914,746 (“*Matthews*”), and in further view of U.S. Patent Number 5,929,849 (“*Kikinis*”).

VII. ARGUMENTS

Applicants respectfully submit that Applicant’s claims 134 – 138 are patentable under 35 U.S.C. §103. It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicants respectfully traverse the rejections described in the Final Office Action and repeated in the Advisory Action and Pre-Appeal Review. For the reasons set forth below, Applicants respectfully request that the Board of Patent Appeals overturn the final rejection of those claims.

A. The Cited References

1. The *White* Reference

White appears to disclose an “entertainment head-end [that] provides broadcast programming, video-on-demand services, and HTML-based interactive programming through a distribution network to client terminals in subscribers’ homes” (Abstract). For example, *White* appears to disclose a “video-on-demand selection screen” (column 1, line 54) that includes, “a topical listing of movie categories 66; a feature 68... and other advertising 72” (column 4, line 14 and FIG. 4).

2. The *Neel* Reference

Neel appears to disclose an interactive video services system for enabling store and forward distribution of digitized video programming” (Abstract). For example, *Neel*, at most, appears to disclose a “graphics screen [that] asks the user if he or she wants to be billed for the movie or, instead, if they want to watch one or more advertisements and pay for the movie (column 17, line 46 and FIG 7A).

3. The *Bee* Reference

Bee, at most, appears to disclose “[s]tudios spend tens of thousands of dollars on trailers, the industry term for what audiences know as ‘previews of coming attractions’” (page 2, paragraph 2).

4. The *Matthews* Reference

Matthews, at most, appears to disclose a subscriber interface unit [that] maintains a virtual channel table having entries for a plurality of virtual channel numbers” (Abstract).

B. Applicants’ Claims

1. Rejection of Independent Claim 134

The Office Action rejects claim 134 under 35 U.S.C. § 103(a) as being allegedly anticipated by *White* in view of *Neel* in view of the *Bee* article, and in further view of *Matthews*.

Independent claim 134 recites:

A television set-top terminal (“STT”) coupled to a server via a bi-

directional communication network, said STT comprising:

- memory having at least one program code stored therein;
- at least one processor that is programmed by the program code to enable the STT to:
 - receive via tuner in the STT media guide data corresponding to a media guide for on-demand rentable video presentations;
 - provide a media guide presentation to a user via a television signal, the media guide presentation comprising at least a portion of the media guide data corresponding to a plurality of on-demand rentable video presentations;
 - responsive to presentation specific rent flags received from the server, enable a plurality of user-selectable rental options specific to each one of the plurality of on-demand rentable video presentations in the media guide presentation;
 - configure *a first rental option* in the plurality of user-selectable rental options to provide a user-selectable option to *view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation* of the user-selected on-demand rentable video presentation;
 - configure *a second rental option* in the plurality of user-selectable rental options to provide a user-selectable option to *view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation* of the user-selected on-demand rentable video presentation;
 - receive a first user input corresponding to a selection of one of the plurality of on-demand rentable video presentations in the media guide presentation;
 - provide the first rental option and the second rental option to the user responsive to the first user input;
 - receive a second user input responsive to providing the first rental option and the second rental option;
 - provide the one of the plurality of rentable video presentations to the user without presentation promotional advertising during the presentation and without preceding movie trailers responsive to the second user input corresponding to the selection of the first rental option and the second rental option; and
 - suspend the provision of the rentable video presentation and provide the user with suspension promotional advertising responsive to third user input, wherein the suspension promotional advertising provided during suspension of the presentation is configured by the server and is independent of the presentation and independent of the first rental option and the second rental option. *(emphasis added)*

Independent claim 134 is allowable for at least the reason that the cited art fails to

disclose, teach, or suggest “*a first rental option... to view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation* of the user-selected on-demand rentable video presentation [and] *a second rental option* in the plurality of user-selectable rental options to provide a user-selectable option to *view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation* of the user-selected on-demand rentable video presentation” as recited in claim 134.

For example, *Neel* is introduced in the proposed combination to teach a first rental option and a second rental option. However, *Neel* fails to suggest “*a first rental option... to view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation* of the user-selected on-demand rentable video presentation [and] *a second rental option* in the plurality of user-selectable rental options to provide a user-selectable option to *view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation* of the user-selected on-demand rentable video presentation” as recited in claim 134.

In particular, *Neel* discloses “a graphics screen [that] asks the user if he or she wants to be billed for the movie or, instead, if they want to watch one or more advertisements and have the advertisers pay for the movie” (see also *Neel* col. 17, line 46). Additionally, FIG. 7a of *Neel* illustrates the option discussed above as allowing a user to “be charged \$4.95 for the movie” or “be shown a fifteen minute interactive advertisement.” However, nowhere does *Neel* disclose “*a first rental option... to view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation* of the user-

selected on-demand rentable video presentation *[and] a second rental option* in the plurality of user-selectable rental options to provide a user-selectable option to *view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation* of the user-selected on-demand rentable video presentation” as recited in claim 134.

With respect to the other references, *White*, at most, seemingly teaches a “promotion 70 of one or more featured video titles; and other advertising 72 (column 4, line 16). *Bee*, at most, appears to teach “evidence of trailers’ popularity” (page 2, paragraph 12). *Matthews*, at most, appears to disclose “maintain[ing] a virtual channel table having entries for a plurality of virtual channel numbers” (Abstract). Accordingly, none of the cited references appears to teach “*a first rental option... to view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation* of the user-selected on-demand rentable video presentation *[and] a second rental option* in the plurality of user-selectable rental options to provide a user-selectable option to *view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation* of the user-selected on-demand rentable video presentation” as recited in claim 134.

Therefore, a *prima facie* case establishing an obviousness rejection has not been made, and the rejection of claim 134 should be withdrawn.

2. Rejection of Dependent Claims 135 – 138

Because independent claim 134 is allowable over the cited art of record, dependent claims 135 – 138 (which depend from independent claim 1) are allowable as a matter of law for

at least the reason that the dependent claims contain all the elements and features of independent claim 134 and the additional cited art in the rejections of the dependent claims, such as *Lawler* (U.S. Patent No. 5,907, 323) and *Kikinis* (U.S. Patent No. 5,929,849), fails to remedy the deficiencies of the cited art in the rejection of claim 134. For at least this reason, the rejections of claims 135 – 138 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claims 135 – 138, these dependent claims recite further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the cited art of record.

VIII. CONCLUSION

Based upon the foregoing discussion, Applicants respectfully request that the Examiner's final rejection of claims 134 – 138 be overruled by the Board, and that the application be allowed to issue as a patent with all pending claims. In addition to the claims shown in the Claims Appendix IX, Appendix X attached hereto indicates that there is no evidence being attached and relied upon by this brief. Appendix XI attached hereto indicates that there are no related proceedings.

The PTO is authorized to charge the \$500 fee for this Appeal Brief to the credit account identified in the accompanying credit card authorization form. No additional fee is believed to be due in connection with this appeal. If, however, any additional fee is deemed to be payable, you are hereby authorized to charge any such fee to deposit account 20-0778.

Respectfully submitted,



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IX. CLAIMS APPENDIX

134. A television set-top terminal ("STT") coupled to a server via a bi-directional communication network, said STT comprising:

memory having at least one program code stored therein;

at least one processor that is programmed by the program code to enable the STT to:

receive via tuner in the STT media guide data corresponding to a media guide for on-demand rentable video presentations;

provide a media guide presentation to a user via a television signal, the media guide presentation comprising at least a portion of the media guide data corresponding to a plurality of on-demand rentable video presentations; responsive to presentation specific rent flags received from the server, enable a plurality of user-selectable rental options specific to each one of the plurality of on-demand rentable video presentations in the media guide presentation;

configure a first rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation of the user-selected on-demand rentable video presentation;

configure a second rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation of the user-selected

on-demand rentable video presentation;
receive a first user input corresponding to a selection of one of the plurality of on-demand rentable video presentations in the media guide presentation;
provide the first rental option and the second rental option to the user responsive to the first user input;
receive a second user input responsive to providing the first rental option and the second rental option;
provide the one of the plurality of rentable video presentations to the user without presentation promotional advertising during the presentation and without preceding movie trailers responsive to the second user input corresponding to the selection of the first rental option and the second rental option; and
suspend the provision of the rentable video presentation and provide the user with suspension promotional advertising responsive to third user input, wherein the suspension promotional advertising provided during suspension of the presentation is configured by the server and is independent of the presentation and independent of the first rental option and the second rental option.

135. The STT of claim 134, wherein the suspension promotional advertising provided during suspension of the presentation corresponds to movie trailers provided through a movie trailer channel to which the STT tunes during the suspension of the presentation, wherein the user is provided an option to purchase for future rental at least one movie

corresponding to the movie trailers during the suspension of the presentation

136. The STT of claim 134, wherein the presentation promotional advertising corresponds to logos provided to the user with the one of the plurality of rentable video presentations.

137. The STT of claim 134, wherein the presentation promotional advertising corresponds to brands provided to the user with the one of the plurality of rentable video presentations.

138. The STT of claim 134, wherein the presentation promotional advertising corresponds to marks provided to the user with the one of the plurality of rentable video presentations.

X. EVIDENCE APPENDIX

(None)

XII. RELATED PROCEEDINGS APPENDIX

(None)